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EXAMINER

COLAN, GIOVANNA B

ART UNIT PAPER NUMBER

2162

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,681

Applicant(s)

MARMAROS ET AL.

Examiner

Giovanna Colan

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 23-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 54-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/25/04, 09/30/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is issued in response to applicant filed application on 09/30/2003.
2. Claims 1 – 59 are pending.
3. On amendment dated 04/25/2006, Applicant elected Group I, claims 1 – 22 and 54 – 59 with traverse.
4. The information disclosure statement (IDS) submitted on 03/25/2004, and 09/30/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Election/Restrictions

5. Applicant's election with traverse of Group I with traverse in the reply filed on 04/25/2006 is acknowledged.

The traversal is on the ground(s) that the Examiner has not satisfied this burden with Groups I – IV; and that for example, claim 1: receiving a search query, receiving first search results based at least in part on a search performed using the search query, and/or performing a search of a history database using the search query to obtain second search results. This is not found persuasive because of the reasons discussed below.

Group I, Claims 1 – 22, and 54 – 59, discloses the steps of 1) receiving a search query, 2) receiving first search results, 3) performing a search of a history database to obtain second search results, 4) modifying the first search results, and 5) outputting the modified first search results.

Group II discloses 1) receiving search results, 2) determining whether one or more of the search results correspond to information in the history database, 3) reordering (sorting) the search results, and 4) outputting the reordered search results. Regarding Group I and II, both of the groups do disclose the step of searching using a query and outputting or displaying the results. However, Group I clearly discloses two sets of search results, such as, first search results and second search results; and Group II discloses one set of search results. In addition, Group I discloses modifying the first search results; and Group II clearly discloses ordering (sorting) and reordering (resorting) search results. It is clear that in order for invention of Group I to successfully work (display or output results) it does not need of steps, such as, ordering/reordering and utilizing one single set of search results, included in Group II.

Group III discloses 1) obtaining search results, 2) determining whether one or more of the search results correspond to information in the history database, 3) moving positions of the search results, and 3) presenting the search results. Regarding Group I and III, both of the groups do disclose search and displaying search results; however, Group I does not disclose the specific limitation of Group III that includes determining whether the search results correspond to information in the history database (pattern matching). In addition, Group III discloses a single set of search results. Instead, Group

I discloses a first and second set of search results. It is clear that in order for invention of Group I to successfully work (display or output results) it does not need of the step of pattern matching (included in Group III).

Group IV discloses 1) storing information, 2) receiving a search query, 3) searching the history database, 3) ranking the search results, and 4) outputting the ranked search results. Regarding Group I, and IV, both of the groups do disclose search and displaying search results; however, Group I does not disclose the specific limitation of Group IV that includes ranking search results (augmenting and/or refining the search results returned by a query). In addition, Group IV discloses a single set of search results. It is clear that in order for invention of Group I to successfully work (display or output results) it does not need of the step of ranking search results (included in Group IV).

Same thought has been applied to the other group combinations. For all the reasons explained above, each of these four inventions contain features that might be combinable to work together; however, each of them does not specifically need of the others to successfully work.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1 – 8, 10 – 13, 15 – 22, and 54 – 59 rejected under 35 U.S.C. 103(a) as being unpatentable over Awadallah et al. (Awadallah hereinafter) (US Patent App. Pub. 2005/0027699 A1, filed on August 1, 2003) in view of Microsoft Corporation (Microsoft hereinafter) (NPL: "Find and Return to Web Page You've Recently Visited", Posted March 26, 2003, Internet Explorer, Microsoft Corporation).

Regarding Claims 1, Awadallah discloses a method for providing search results, comprising:

receiving a search query (Fig. 1, item 152, Page 4, [0041], lines 1 – 2, Awadallah);

receiving first search results based at least in part on a search performed using the search query (Fig. 1, item 154, Page 4, [0041], lines 2 – 4, Awadallah);

Awadallah further discloses history database storing information regarding prior document accesses (Page 4 and 5, [0039] and [0051], lines 11 – 15 and 12 – 15, a previous search history; respectively, Awadallah) and obtaining a second search results (Page 4, [0041], lines 4 – 8, candidate search results, Awadallah). However, Awadallah does not expressly disclose: performing a search of a history database using the search query to obtain these second search results. On the other hand, Microsoft discloses performing a search of a history database using the search query to obtain the second search results (Page 4, para. 1, lines 1 – 4, Microsoft), the history database storing information regarding prior document accesses (Page 1, para. 1, lines 1 – 7, Microsoft). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Microsoft's teachings to the system Awadallah. Skilled artisan would have been motivated to do so, as suggested by Microsoft (Page 2, para1, lines 1 – 4, Microsoft), to allow users to find and/ or return to interesting web pages that they visited today of a few weeks ago. In addition, both of the references (Awadallah and Microsoft) teach features that are directed to analogous art and they are directed to the same field of endeavor, such as, databases management systems, search engines, receiving queries, search results, and search histories. This close relation between both of the references highly suggests an expectation of success.

The combination of Awadallah in view of Microsoft ("Awadallah/Microsoft" hereinafter) further discloses:

modifying the first search results based at least in part on the second search results (Page 6, [0065], lines 20 – 28, Awadallah¹); and

outputting the modified first search results (Page 2, [0020], lines 1 – 8, links displayable on a webpage, Awadallah).

Regarding Claims 2, Awadallah/Microsoft discloses a method, wherein the receiving first search results includes:

transmitting the search query to an external search engine (Fig. 1, item 152, Page 4, [0041], lines 1 – 2, Awadallah), the search engine generating the first search results (Fig. 1, item 154, Page 4, [0041], lines 2 – 4, Awadallah);

intercepting the first search results (Page 4, [0044], lines 5 – 9, Awadallah), and parsing the first search results to identify information contained in the first search results (Page 4, [0044], lines 5 – 9, selected from candidate results, Awadallah).

Regarding Claims 3, Awadallah/Microsoft discloses a method, wherein the performing a search of history database includes:

identifying one or more search terms used in the search query (Page 4, para. 2, lines 1 – 2, type the term or phrase you're looking for, Microsoft),

¹ Wherein the step of combining the listing of search results corresponds to the step of modifying the results claimed.

using the one or more search terms to search the history database (Page 4, para. 2, lines 1 – 2, click search Now, Microsoft).

Regarding Claims 4, Awadallah/Microsoft discloses a method, wherein the one or more search terms are identified from information returned from a search engine (Page 2, [0023], lines 1 – 4, Awadallah).

Regarding Claims 5, Awadallah/Microsoft discloses a method, wherein the first search results include links to documents (Page 2, [0020], lines 5 – 8, the links comprise the search results, documents, Awadallah).

Regarding Claims 6, Awadallah/Microsoft discloses a method, further comprising: ranking the second search results by at least one of date (Page 3, para. 3, lines 1 – 2, by date, Awadallah), relevancy to the search query (Page 3, para. 3, lines 1 – 2, by most visited, Awadallah), and how much the second search results are thought to be liked by a user (Page 3, para. 3, lines 1 – 2, by most visited, Awadallah).

Regarding Claims 7, Awadallah/Microsoft discloses a method, wherein the modifying the first search results includes:

determining whether a top one or more of the second search results are included in the first search results (Page 4, [0041] and [0044], lines 13 – 15 and 7 – 9; respectively, Awadallah²), and

adding the top one or more of the second search results to the first search results when the top one or more of the second search results are not included in the first search results (Page 4, [0041], lines 11 – 16, composite search results, Awadallah).

Regarding Claims 8, Awadallah/Microsoft discloses a method, wherein the adding the top one or more of the second search results includes:

placing the top one or more of the second search results at a prominent position in the first search results (Page 4, [0045], lines 1 – 5, Awadallah).

Regarding Claims 10, Awadallah/Microsoft discloses a method, wherein the modifying the first search results includes:

determining whether one or more of the second search results are included in the first search results (Page 4, [0041], lines 13 – 15, returns a composite of different amounts of candidate search results, Awadallah), and

reordering the first search results when the one or more of the second search results are included in the first search results (Page 5, [0045], lines 13 – 17, Awadallah).

² Wherein the step of returning different or equal combined results corresponds implies the step of determining whether the top one or more second results are included in the first search results as claimed.

Regarding Claims 11, Awadallah/Microsoft discloses a method, wherein the reordering the first search results includes:

moving positions of the one or more of the second search results within the first search results (Page 5, [0045], lines 13 – 17, Awadallah).

Regarding Claims 12, Awadallah/Microsoft discloses a method, wherein the moving positions of the one or more of the second search results includes moving the one or more of the second search results a predetermined number of positions toward a top of the first search results (Page 5, [0045] and [0052], lines 13 – 17 and 7 – 13, ranking; respectively, Awadallah).

Regarding Claims 13, Awadallah/Microsoft discloses a method, wherein the predetermined number of positions is user-configurable (Page 5, [0052], lines 9 – 13, Awadallah).

Regarding Claims 15, Awadallah/Microsoft discloses a method, wherein the modifying the first search results includes:

analyzing the first search results against the information in the history database, and reordering the first search results based at least in part on the analysis (Page 5, [0052], lines 6 – 9, Awadallah³).

³ Wherein the step of using a side- by- side comparison corresponds to the step of analyzing claimed.

Regarding Claims 16, Awadallah/Microsoft discloses a method, wherein the reordering the first search results includes moving positions of one or more of the first search results when the one or more of the first search results match information in the history database (Page 5, [0052], lines 7 – 13, Awadallah⁴; and Page 3, para. 3, lines 1 – 4, choose how you want to sort the web pages, Microsoft).

Regarding Claims 17, Awadallah/Microsoft discloses method, wherein the second search results are associated with local documents (Page 2, [0020], lines 5 – 8, Awadallah).

Regarding Claims 18, Awadallah/Microsoft discloses a method, wherein the local documents include at least one of e-mails, images, application files, audio files, and video files (Page 2, [0020], lines 5 – 8, Awadallah).

Regarding Claims 19, Awadallah/Microsoft discloses a method, wherein the second search results are associated with local documents and non-local documents (Page 2, [0020], lines 5 – 13, web pages, advertisements, Awadallah; and Page 3, para.3, lines 1 – 4, Web pages, Microsoft).

Regarding Claims 20, Awadallah/Microsoft discloses a system for providing search results, comprising:

⁴ Wherein the step of ranking the desirability corresponds to the step of reordering claimed; and the step

means for obtaining first search results based at least in part on a search performed on a document corpus using a search query (Fig. 1, item 154, Page 4, [0041], lines 2 – 4, Awadallah);

means for generating second search results based at least in part on a search performed on information regarding prior document accesses using the search query (Page 4, [0041], lines 4 – 8, candidate search results, Awadallah; and Page 4, para. 1, lines 1 – 4, Microsoft);

modifying the first search results based at least in part on the second search results (Page 6, [0065], lines 20 – 28, Awadallah⁵);

outputting the modified first search results (Page 2, [0020], lines 1 – 8, links displayable on a webpage, Awadallah).

Regarding Claims 21, Awadallah/Microsoft discloses a system, comprising:
a history database configured to store information regarding prior document accesses by a user (Page 1 and 4, para. 1 and 1, lines 1 – 7 and 1 – 4; respectively, Microsoft); and

a browser assistant (Page 4, [0040], lines 1 – 2, browser, Awadallah) configured to:

obtain first search results based at least in part on a search performed on a document corpus using a search query (Fig. 1, item 154, Page 4, [0041], lines 2 – 4, Awadallah),

of comparing the response corresponds to the step of matching claimed.

obtain second search results based at least in part on a search performed on the history database using the search query(Page 4, [0041], lines 4 – 8, candidate search results, Awadallah; and Page 4, para. 1, lines 1 – 4, Microsoft), modify the first search results based at least in part on the second search results (Page 6, [0065], lines 20 – 28, Awadallah⁶), and present the modified first search results to the user (Page 2, [0020], lines 1 – 8, links displayable on a webpage, Awadallah).

Regarding Claims 22, Awadallah/Microsoft discloses a computer-readable medium that stores instructions executable by at least one processor to perform a method for providing search results, the computer-readable medium comprising:

instructions for obtaining a search query (Fig. 1, item 152, Page 4, [0041], lines 1 – 2, Awadallah);

instructions for obtaining first search results based at least in part on a search performed using the search query (Fig. 1, item 154, Page 4, [0041], lines 2 – 4, Awadallah);

instructions for performing a search of a history database using the search query to obtain second search results (Page 4, [0041], lines 4 – 8, candidate search results, Awadallah; and Page 4, para. 1, lines 1 – 4, Microsoft), the history database storing

⁵ Wherein the step of combining the listing of search results corresponds to the step of modifying the results claimed.

⁶ Wherein the step of combining the listing of search results corresponds to the step of modifying the results claimed.

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information regarding previous document accesses (Page 1, para. 1, lines 1 – 7, Microsoft);

instructions for modifying the first search results based at least in part on the second search results (Page 6, [0065], lines 20 – 28, Awadallah⁷); and

instructions for presenting the modified first search results (Page 2, [0020], lines 1 – 8, links displayable on a webpage, Awadallah).

Regarding Claims 54, Awadallah/Microsoft discloses a method comprising:

receiving a search query (Fig. 1, item 152, Page 4, [0041], lines 1 – 2, Awadallah);

searching a history database based at least in part on the search query to obtain search results (Page 4, [0041], lines 4 – 8, candidate search results, Awadallah; and Page 4, para. 1, lines 1 – 4, Microsoft), the history database storing information regarding previous document accesses (Page 1, para. 1, lines 1 – 7, Microsoft);

obtaining one or more advertisements relating to the search query (Page 5, [0046], lines 1 – 4, Awadallah); and

presenting the search results (Page 2, [0020], lines 1 – 8, links displayable on a webpage, Awadallah) and the one or more advertisements (Page 5, [0046], lines 1 – 4, Awadallah).

⁷ Wherein the step of combining the listing of search results corresponds to the step of modifying the results claimed.

Regarding Claims 55, Awadallah/Microsoft discloses a method, wherein the obtaining one or more advertisements includes:

sending the search query to an external server (Page 4, [0040], lines 5 – 10, Awadallah), and

obtaining, from the external server, the one or more advertisements that relate to the search query (Page 5, [0046], lines 1 – 7, Awadallah).

Regarding Claims 56, Awadallah/Microsoft discloses a method for providing search results, comprising:

receiving a search query (Fig. 1, item 152, Page 4, [0041], lines 1 – 2, Awadallah),

receiving first search results based at least in part on a search performed using the search query (Fig. 1, item 154, Page 4, [0041], lines 2 – 4, Awadallah);

performing a search of a history database using the search query to obtain second search results (Page 4, [0041], lines 4 – 8, candidate search results, Awadallah; and Page 4, para. 1, lines 1 – 4, Microsoft), the history database storing information regarding prior document accesses (Page 1, para. 1, lines 1 – 7, Microsoft);

presenting the first search results and the second search results (Page 2, [0020], lines 1 – 8, links displayable on a webpage, Awadallah).

Regarding Claims 57, Awadallah/Microsoft discloses a method, wherein the presenting the first search results and the second search results includes placing the

first search results in a first window and the second search results in a second window (Page 4, [0045], lines 1 – 5, search results page in distinctly different regions, Awadallah).

Regarding Claims 58, Awadallah/Microsoft discloses a method, wherein the second window is one of a pop-up and a drop-down window (Page 1, para. 3, figure showing the “Forward button on the Internet”, Microsoft).

Regarding Claims 59, Awadallah/Microsoft discloses a method, wherein the presenting the first search results and the second search results includes incorporating the first search results and the second search results in a same window (Page 4, [0045], lines 1 – 5, results from source 1, results from source 2... are placed on a search results page, Awadallah).

9. Claims 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Awadallah et al. (Awadallah hereinafter) (US Patent App. Pub. 2005/0027699 A1, filed on August 1, 2003) in view of Microsoft Corporation (Microsoft hereinafter) (NPL: “Find and Return to Web Page You’ve Recently Visited”, Posted March 26, 2003, Internet Explorer, Microsoft Corporation), and further in view of Milic-Frayling et al. (Milic-Frayling hereinafter) (US Patent No. 6,968,332 B1, filed: May 25, 2000).

Regarding Claims 9, Awadallah/Microsoft discloses a method, wherein the adding the top one or more of the second search results further includes: the top one or more of the second search results at the prominent position in the first search results (Page 4, [0045], lines 1 – 5, Awadallah). However, Awadallah/Microsoft is silent with respect to highlighting. On the other hand, Milic-Frayling discloses highlighting documents searched according to their relevance (Col. 16, lines 28 – 33, Milic-Frayling). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Milic-Frayling's teachings to the system of Awadallah/Microsoft. Skilled artisan would have been motivated to do so, as suggested by Milic-Frayling (Col. 16, lines 42 – 49, Milic-Frayling), to facilitated reading, comprehension, and assimilation of information found in the accessed documents, and to assess and rank search engines in a consisted manner. In addition, both of the references (Awadallah, Microsoft, and Milic-Frayling) teach features that are directed to analogous art and they are directed to the same field of endeavor, such as, databases management systems, search engines, querying search engine, and ranking. This close relation between both of the references highly suggests an expectation of success.

Regarding Claims 14, the combination of Awadallah in view of Microsoft and further in view of Milic-Frayling ("Awadallah/Microsoft/Milic-Frayling" hereinafter) discloses a method, wherein the modifying the first search results includes:

determining whether one or more of the second search results are included in the first search results (Page 4, [0041] and [0044], lines 13 – 15 and 7 – 9; respectively, Awadallah⁸), and

highlighting the first search results when the one or more of the second search results are included in the first search results (Col. 16, lines 28 – 33, Milic-Frayling).

Prior Art Made Of Record

1. Awadallah et al. (US Patent App. Pub. 2005/0027699 A1, filed: August 1, 2003) discloses listings optimization using a plurality of data sources.
2. Microsoft Corporation (NPL: "Find and Return to Web Page You've Recently Visited", Posted March 26, 2003, Internet Explorer, Microsoft Corporation).

⁸ Wherein the step of returning different or equal combined results corresponds implies the step of determining whether the top one or more second results are included in the first search results as claimed.

3. Milic-Frayling et al. (US Patent No. 6,968,332 B1, filed: May 25, 2000) discloses a facility for highlighting documents accessed through search or browsing.

Points Of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna Colan whose telephone number is (571) 272-2752. The examiner can normally be reached on 8:30 am - 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Giovanna Colan
Examiner
Art Unit 2162
June 14, 2006


JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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